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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Anne O'Malley

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EXAMINER

NGUYEN, HIEP VAN

ART UNIT

PAPER NUMBER

3626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/608,792	O'MALLEY ET AL.	
	Examiner	Art Unit	
	HIEP NGUYEN	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/11/04, 10/11/04, 10/14/04, 11/18/04, 2/4/05,</u> | 6) <input type="checkbox"/> Other: _____ |
| <u>2/7/05, 4/28/05, 8/23/07, 6/10/08, 6/10/08, 6/10/08</u> | |

DETAILED ACTION

Status

1. Claims 1-25 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "substantially" in claims 10 and 19 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

5. Claim 20 is rejected as the scope is unclear. Specifically, Claim 12 is directed to a "system". However, the limitation in Claim 20 which depends from Claim 12 recites to a "method system", therefore, the scope of this claim is unclear (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989))

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-25 are rejected under 35 U.S.C.102(e) as being anticipated by Bonalle et al. (US. 7,119,659.)

8. With respect to Claim 1, Bonalle et al. teaches a system for membership enrollment comprising:

- a. an enrollment system including an enrollment system server for processing data in connection with a user ('659; Col. 3, lines 1-3; lines 46-65.)
- b. a first supplier system for providing a first membership indicia to said enrollment system in response to said data ('659; Col.3, lines 5-8; lines 32-35);
- c. a second supplier system for providing a second membership indicia to said enrollment system in response to said user data, said second membership indicia different from said first membership indicia ('659; Col. 3, lines 8-16; lines 32-45);

- d. a readable storage device including database for storing said first and second membership indicia, and said user data ('659; Col. 3, lines 17-31, lines 40-45); and
 - e. an enrollment system reader in communication with said readable storage device and said enrollment system server, said reader receiving said user data ('659; Col/line 7/51-8/18.)
9. With respect to Claim 2, Bonalle et al. teaches a system according to Claim 1, wherein said reader is in communication with said enrollment system for providing said user data to said first and second supplier ('659; Col./ line 16/56-17/7.)
10. With respect to Claim 3, Bonalle et al. teaches a system according to Claim 1 wherein said enrollment system server provides said first and second membership indicia to said readable storage device, said readable storage device storing said first and second membership indicia in said readable storage device database ('659; Col/line 12/58-13/4.)
11. With respect to Claim 4, Bonalle et al. teaches a system according to Claim 3, wherein said readable storage device database further includes a rewards data file for storing rewards value ('659; Col. 4, lines 3-5; Col. 37, lines 5-9. The Examiner notes the loyalty points stored in database considered as said rewards value.)

12. With respect to Claim 5, Bonalle et al. teaches a system according to Claim 4, further including a first supplier reader and a second supplier reader, said first and second supplier readers in communication with said enrollment system, said first and second supplier readers for providing said .interrogation signal and receiving at least one of said first and second membership indicia ('659; Col. 28, lines 4-56.)

13. With respect to Claim 6, Bonalle et al. teaches a system according to Claim 5, wherein at least one of said first and second supplier systems provides value to said rewards data file ('659; Col. 4, lines 1-18: distinct data sets (i. e. first and second supplier systems.))

14. With respect to Claim 7, Bonalle et al. teaches a system according to Claim 6, wherein said value is provided in accordance with said user data ('659; Col. 8, lines 19-33; Col. 37, lines 5-9.)

15. With respect to Claim 8, Bonalle et al. teaches a system according to Claim 7, wherein said value is provided in response to-receipt of said user data ('659; Col. 8, lines 19-33; lines 44-59.)

16. With respect to Claim 9, Bonalle et al. teaches a system according to Claim 3, wherein said readable storage device stores said first membership indicia prior to storing said second membership indicia ('659; Col. 3, lines 1-16).

17. With respect to Claim 10, Bonalle et al. teaches a system according to Claim 3, wherein said readable storage device stores said first and second membership indicia substantially simultaneously ('659; Col. 3, lines 1-16.)

18. With respect to Claim 11, Bonalle et al. teaches a method system according to Claim 3, wherein said readable storage device stores at least one of said first and second membership indicia automatically ('659; Col. 32-45.)

19. With respect to Claim 12, Bonalle et al. teaches a system for membership enrollment comprising:

- f. an enrollment system including an enrollment system server for processing data in connection with a user ('659; Col. 3, lines 1-3; lines 46-65);
- g. a first supplier system for providing a first membership indicia to said enrollment system in response to said user data ('659; Col.3, lines 5-8; lines 32-35);
- h. a second supplier system for providing a second membership indicia to said enrollment system in response to said user data, said second membership indicia different from said first membership indicia ('659; Col. 3, lines 8-16; lines 32-45) ;
- i. a radio frequency identification (RFID) storage device including a transponder system in communication with a transponder system database for

storing said first and second membership indicia, and said user data, said transponder system for receiving an interrogation signal, providing said user data and receiving at least one of said first and second membership indicia ('659; Col. 29, lines 45-47; Col. 30, lines 25-37, lines 38-50);

j. an RFID reader in communication with said RFID storage device and said enrollment system server, said RFID reader for providing said interrogation signal, receiving said user data, and providing at least one of said first and second membership indicia ('659; Col. 28, lines 18-44.)

20. With respect to Claims 13-20, they are system claims which repeat the same limitations of claims 2-4, 6-7, 9-11, the corresponding system claims, as a collection of elements as opposed to a series of process steps. Since the teachings of Bonalle et al. disclose the underlying process steps that constitute the systems of claims 2-4, 6-7, 9-11, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 13-20 are rejected for the same reasons given above for claims 2-4, 6-7, 9-11.

21. With respect to Claim 21, Bonalle et al. teaches a method of enrolling a user in a membership program comprising:

k. receiving user specific data at a universal enrollment system ('659; Col 12, lines 42-45)

- l. providing the user specific data to a plurality of service providers ('659, col. 12, lines 42-45);
 - m. receiving from the plurality of service providers unique membership numbers ('659; Col. 5, lines 38-48);
 - n. transferring the unique membership numbers to a portable handheld user storage device, the storage device including a database containing a unique storage area for each unique membership number ('659; Col./line 12/58-13/4).
22. With respect to Claim 22, Bonalle et al. teaches a method according to claim 21 further comprising:
- o. receiving at least one of the unique membership numbers from the storage device upon presentation of the device to a first service provider, the unique membership number identifying the user as a member of a first service provider membership program ('659; col. 3, lines 1-16);
 - p. authenticating authenticity of at least the membership number and user ('659; Col. 30, lines 38-62);
 - q. providing rewards points to the storage device in accordance with at least one of the unique membership number and a transaction indicia ; and providing means for storing the rewards points for later redemption ('659; Col. 4, lines 3-5; Col. 37, lines 5-9. The Examiner notes the loyalty points stored in database considered as said rewards value.).

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23. With respect to Claims 23-24, they are method claims which repeat the same limitations of claims 21-22, the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the teachings of bonalle et al. disclose the underlying process steps that constitute the methods of claims 23-24, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 23-24 are rejected for the same reasons given above for claims 21-22.

24. With respect to Claim 25, Bonalle et al. teaches a method according to 24, wherein the transfer of at least one of said rewards points, user data, and unique membership number is via RF ('659; Col. 8, lines 28-59.)

Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HIEP NGUYEN whose telephone number is (571)270-5211. The examiner can normally be reached on Monday through Friday 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HIEP NGUYEN/
Examiner, Art Unit 3626

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626